

REMARKS

The Applicant has filed the present Response in reply to the outstanding Official Action of January 12, 2005, and the Applicant believes the Response to be fully responsive to the Official Action for the reasons set forth below in greater detail.

In the outstanding Official Action, the Examiner rejected Claims 1, 6-11 and 14-16 under 35 U.S.C. § 103(a) as being obvious in view of Matsuda. Applicant respectfully disagrees with the rejection and traverses with at least the following analysis.

The Examiner asserts that "although the reference does not specifically disclose spreading data of a plurality of branches to produce despread data each corresponding to a plurality of fingers and frequency offset for each finger, such limitation are merely a matter of design choice." See Official Action, July 12, 2005, page 3. Applicant respectfully disagrees with the Examiner that such features are "merely a matter of design choice". Additionally, Applicant respectfully submits that the reference fails to teach, suggest or render obvious each and every element of the claims.

First, the cited reference is directed to a TDMA receiver/transmitter, whereas in stark contrast, the claimed invention is directed to a mobile telephone apparatus operable in a **CDMA communication system**. A TDMA apparatus cannot be used for CDMA communication. Both the CDMA and TDMA systems operate in substantially different ways that affect what elements are needed for proper functionality. In a TDMA apparatus, reception occurs in bursts, whereas, in a CDMA apparatus multiple signals share the same time slot and reception is continuous. Multiple communication signals are multiplexed together and modulated to create a spread-spectrum signal. The receiver contains a plurality of fingers for reception. However, none of

these features are present in a TDMA system. Accordingly, Matsuda fails to teach a despreading circuit for *despreading received spectrum-spread data of a plurality of branches to produce despread data each corresponding a plurality of fingers*, as recited in Claim 1.

This element is not merely a design choice, but rather a feature needed for proper operation of the claimed invention.

Additionally, there is no motivation to modify Matsuda to have this feature. It has been held by the courts that to establish *prima facie* obviousness, there must be some suggestion or motivation to modify the reference. See In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). The absence of such a suggestion to combine is dispositive in an obviousness determination. See Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997). “The showing of a motivation to combine must be clear and particular, and it must be supported by actual evidence.” Teleflex, Inc. v. Ficosa North American Corp., 299 F.3d 1313, 63 USPQ2d 1374 (Fed. Cir. 2002) (citing In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999)).

There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998). The motivation can come from the nature of the problem, the reference, or common knowledge. Id. The Federal Circuit stated:

[V]irtually all [inventions] are combinations of old elements. Therefore an Examiner may often find every element of a claimed invention in the prior art. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an Examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be “an illogical and inappropriate process by which to determine patentability.” To prevent the use of hind sight based on

the invention to defeat patentability of the invention, this court requires the Examiner to show a motivation to combine the references that create the case of obviousness. The Board [of Appeals] did not, however, explain what specific understanding or technological principle within the knowledge of one of ordinary skill in the art would have suggested the combination. ... To counter this potential weakness in the obviousness construct **the suggestion to combine [modify] requirements stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness.**

In re Rouffet, 47 USPQ2d 1457-58 (Fed. Cir.1998) (citations omitted, emphasis added).

That the combination of references *would result* in a claimed invention is only part of the 35 U.S.C. § 103 analysis, the Examiner must also show a motivation or suggestion for modifying the references, this the Examiner has not done. Such conclusory statements are insufficient to show a motivation or suggestion to modify the references. Ecolochem, Inc. v. Southern California Edison Co., 227 F.3d 1361, 1372, 56 USPQ2d 1065, 1073 (Fed. Cir. 2000).

Additionally, the mere fact the reference can be combined or modified does not render the resultant combination obvious. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Although a prior art reference “may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.” Id. at 682.

A TDMA does not need this element as a result of its receiving method, therefore, one of ordinary skill in the art would not modify the reference. Additionally, this modification would change the principle operation of the reference.

Second, Applicant submits that the Examiner incorrectly asserts that Matsuda inherently teaches a frequency offset detector for detecting a frequency offset. The Examiner believes that element 21 is the frequency offset detector. However, element 21 is the RSSI calculator. There is no mention that a frequency offset should be calculated. The reference only states that the

received signal strength indicator detects the **strength** of the radio-frequency signal supplied to the terminal apparatus. The demodulated signal is input into the RSSI section. To support a *prima facie* case of anticipation by inherency, the limitation in question must “necessarily” be present in the prior art reference. In re Robertson, 169 F.3d 743, 49 USPQ2d 1949 (Fed. Cir. 1999). “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (*emphasis in original*). A strength of a signal is a measurement of amplitude and not a change in frequency or a frequency shift. These values are two distinct parameters and require two distinct calculations. The Examiner has not met her burden in establishing that a detection of the frequency offset necessarily flows from the reference. “[The Office] may not... resort to speculation, unfounded assumptions, or hindsight reconstruction to support deficiencies in its factual basis.” In re GPAC, Inc., 57 F.3d 1573, 35 USPQ2d 1116, 1123 (Fed. Cir. 1995).

Furthermore, the reference fails to teach that the movement determiner determines whether the mobile telephone is moving at speeds higher than a predetermined speed, “based upon frequency offsets received from the frequency offset detector, as specifically recited in the claim.

As stated above, Applicant submits that the reference does not teach detecting or calculating a frequency offset and, therefore, the reference cannot teach using the value. The RSSI 21 detects the **strength** of the radio-frequency signal supplied to the terminal apparatus.

At best, the reference teaches that the detected strength is input to a fading pitch detection circuit 23 as an RSSI signal. The circuit 23 detects *a fading pitch from the strength detected by*

the RSSI to determine whether a moving speed of the terminal apparatus exceeds a predetermined value. The first comparator 232 compares the digital RSSI signal with a signal having a threshold level of RSSI input to another input terminal of the first comparator 232, and outputs a detection signal whenever the level of the RSSI signal is lower than the threshold level. In other words, the first comparator 232 detects that the value of RSSI is lower than the threshold level. Clearly, a fading pitch is determined by the relative strength of the received field and not the frequency offset as specifically claimed.

Accordingly, Applicant submits that the reference fails to teach each and every limitation of the claim and accordingly submits that Claim 1 is patentably distinct from Matsuda. Applicant further submits that Claim 11 is patentably distinct for at least the same reasoning.

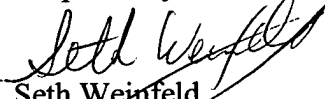
With respect to Claim 6, Applicant respectfully disagrees with the rejection for at least the following additional reasons. Applicant submits that the reference fails to teach a display controller for controlling a display device...such that a message indicating that the mobile telephone apparatus is moving at speeds higher than the predetermined speed is displayed on the display device, as recited. The Examiner identifies element 24 as the display controller. Element 24 is the display, however, there is no teaching that the display displays a message when the apparatus is moving at speeds higher than the predetermined speed. In fact, the reference describes the display as "display section 24 is constituted of, e.g., an LCD (Liquid Crystal Display) to visually display the conditions (calling/called, amount of remaining battery, strength of reception) of a user's own terminal apparatus and dial data read out from a memory section 26 (described later)." See Col. 7, lines 4-9. Accordingly, Applicant submits that Claim 6 is patentably distinct from the cited reference.

Additionally, Applicant submits that Claims 7-10 are patentable based upon their dependency from Claims 1 or 6, respectively, and for the reasons cited above. Lastly, Applicant submits that Claim 14 is patentable for the same reason as Claim 6 and Claims 15-16 are patentable based upon their dependency from Claim 11.

For all the foregoing reasons, the Applicant respectfully requests the Examiner to withdraw the rejection of Claims 1, 6-11 and 14-16 pursuant to 35 U.S.C. § 103(a).

In conclusion, the Applicant believes that the above-identified application is in condition for allowance and henceforth respectfully solicits the Examiner to allow the application. If the Examiner believes a telephone conference might expedite the allowance of this application, the Applicant respectfully requests that the Examiner call the undersigned, Applicant's attorney, at the following telephone number: (516) 742-4343.

Respectfully submitted,


Seth Weinfeld
Registration No. 50,929

Scully, Scott, Murphy & Presser, P.C.
400 Garden City Plaza – Suite 300
Garden City, NY 11530
(516) 742-4343

SW:ae